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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,458	07/18/2000	Eiji Hayashi	862.C1958	8847

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EXAMINER

CHAU, MINH H

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/618,458

Applicant(s)

HAYASHI, EIJI

Examiner

Minh H Chau

Art Unit

2854

-- **Th MAILING DATE of this communication app ars on th cov r she t with the correspond nce address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27, 28, 30-36 and 38-44 is/are rejected.
- 7) ☒ Claim(s) 29 and 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6, 7, 8, 10</u> | 6) <input type="checkbox"/> Other: |

Application/Control Number: 09/618,458
Art Unit: 2854

DETAILED ACTION

Claim Objections

1. Claims 32 and 40 are objected to because of the following informalities: There is no antecedent basis for the recitation "the display unit" as recited in line 10 of both claims 32 and 40. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 27-28, 30, 33-34, 35-36 and 39-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohtani (US # 56,144,818).

With respect to claims 27, 35, 43 and 44, Ohtani teaches a printing control apparatus (2) and a printing control method for controlling a printer (1) having a stapling function (col. 2, line

48 of Ohtani) for binding together a plurality of sheets of printing paper that have been printed out at one of a plurality staplable (Fig. 5) and a plurality of paper feed trays (5) (col. 2, lines 41-42), comprising selection means for selecting a particular paper tray (5) from a plurality of paper feed trays (5) and a limitation means for limiting, on the basis of the paper feed tray selected by the selection means, a usable staplable position from among the plurality of staplable positions (see Figs. 1-9 and cols. 2-5 of Ohtani).

With respect to claim 28 and 36, see cols. 3-4 of Ohtani that teach a desired paper size selection means or setting means by the operator, and the limitation means limits the staplable position on the basis of the size of the printing paper set by the setting means and the feed tray selected by the selection means.

With respect to claims 30 and 38, see Figs. 6-9 of Ohtani that shows display means for displaying of a staplable position and an unstaplable position in the screen of the host computer.

With respect to claims 32 and 40, see cols. 3-4 of Ohtani that teach the printing control apparatus is prepared for in a host computer (2) which communicates with a printer by an interactive interface (11), comprising acquisition means for acquiring paper information, which includes selecting or setting direction and size of the printing paper for each paper feed tray prepared for in the printer, from the printer by the interactive interface according to the designation of a user and the limitation means associates paper information acquired by the acquisition means with the paper information of the paper feed tray selected by the selection means according to the instruction of the user from among the list of a plurality of paper feed trays displayed in the display unit and limits the staplable position on the basis of the associated paper information.

With respect to claims 33 and 41, see Figs. 6-10 of Ohtani that shows a display control means for displaying the paper information of a plurality of paper feed trays acquired by the acquisition means and each of the paper information includes setting direction and size of the paper.

With respect to claims 34 and 42, see cols. 3-4 of Ohtani that teach a device lest generation means for generating device list information, device selection means for selecting the device corresponding to instruction of the user from among lists based on the generated device list information and the acquisition means is for acquiring paper information for each paper feed tray of the device selected by the selection means.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 31 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtani as applied to claims 27 and 35 above, and in view of Koga (US # 6,115,510).

With respect to claims 31 and 39, Ohtani that teach a control means for specifying the staplable position limited by the limitation means and inhibiting a user from selecting and unstaplable position (see Figs. 6-10 and cols. 3-5 of Ohtani).

Ohtani teaches all the limitation except for the "instructing ... reflected" (lines 4-5 of claims 31 and 39), Koga teaches a printer comprising a control printing unit including a control

means for specifying the staple position instruction means for instructing display of staple position setting screen where control result by the control means was reflected (see col. 9 and fig. 12 of Koga).

In view of this teaching, it would have been obvious to one of ordinary skill in the art to modify the device of Ohtani to include the instruction means for instructing display of the staple position by Koga so that the proper selected staple position can be preview by the operator.

Allowable Subject Matter

7. Claims 29 and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

Claims 29 and 37 have been indicated for containing allowable subject matter because the prior art fails to teach the entire combination of a printing control apparatus and a printing control method for controlling a printer including the limitation means for limits the staplable position on the basis of the feed tray selected by the selection means, the size of the printing paper set by the first setting means and the binding location set by the second setting means.

Response to Arguments

9. Applicant's arguments with respect to claims 27-44 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2854

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

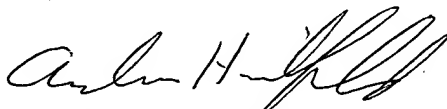
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh H Chau whose telephone number is (703) 305-0298. The examiner can normally be reached on M - TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H Hirshfeld can be reached on (703) 305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5841 for regular communications and (703) 308-5841 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MHC
July 26, 2002


ANDREW H. HIRSHFELD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2854